

REMARKS

I. Status of the Claims

Claims 1-152 are pending in this application. Claims 4, 6, 7, 9, 11-14, 29, 31, 67, 74, 76, 77, 79, 81-84, 99, 101, 115, 117, 118, 120, 122-125, 140, and 142 have been withdrawn.

II. Rejections Under 35 U.S.C. § 103(a)

The Office has rejected claims 1-3, 5, 8, 10, 15-28, 30, 32-66, 68-73, 75, 78, 80, 85-98, 100, 102-114, 116, 119, 121, 126-139, 141, and 142-152 under 35 U.S.C. § 103(a) as allegedly obvious over three sets of references. Applicant respectfully traverses these rejections for at least the reasons set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references must suggest or motivate, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, the modification or combination of references' teachings. Second, there must be a reasonable expectation of success in the modification or combination. Finally, the prior art references must teach or suggest all the claimed limitations. M.P.E.P. §2143.

**A. U.S. Patent No. 6,299,891 in view of Ethox Chemicals
Product Specification for Ethox PEG-6000 DB**

The Office has rejected the claims 1-3, 5, 8, 10, 15-28, 30, 32-66, 68-73, 75, 78, 80, 85-98, 100, 102-114, 116, 119, 121, 126-139, 141, and 142-152 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,299,891 ("Leverett") in view of

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Ethox Chemicals Product Specification for Ethox PEG-6000 DB ("Ethox"). (November 14, 2003, Office Action, pp. 2-3.) Applicant respectfully traverses this rejection.

While the Office acknowledges that Leverett does not expressly teach the particular combination of PEG 150 Dibehenate and sodium stearate of the present invention, it alleges that it would have been obvious to one of ordinary skill in the art at the time the invention to employ the PEG 150 Dibehenate of Ethox as the plasticizer in Leverett's composition "comprising a 'plasticizer' and a metal soap." (November 14, 2003, Office Action, p. 3.) Applicant submits, however, that the Office has failed to set forth a *prima facie* case of obviousness as there is no motivation to combine the references and the express teachings of the references themselves would actually discourage the combination.

In particular, one of ordinary skill in the art would not be motivated to substitute the particular PEG 150 Dibehenate of Ethox for the broad class of "plasticizers" in Leverett, particularly for use with the specific metal soap, sodium stearate, as neither reference teaches or suggests the interchangeability of these materials. Whether a combination or modification of various references is "obvious to try," does not meet the Office's burden for establishing obviousness under 35 U.S.C. § 103. *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1532 (Fed. Cir. 1988).

In fact, one of skill in the art would be lead away from the claimed combination since Leverett teaches that the metal soap serves as the viscosity increasing agent (col. 2, Ins. 46-50), which is the same function as the Ethox PEG 150 Dibehenate, a "[s]uperior viscosity builder." Therefore, it would not have been obvious to substitute an

element of one reference in the other, and one skilled in the art would certainly not have expected to be successful in doing so in light of these teachings. Thus, Applicant respectfully requests withdrawal of this rejection.

B. Ethox Chemicals Product Specification for Ethox PEG-6000 DB in view of U.S. Patent No. 6,165,480

The Office has also rejected claims 1-3, 5, 8, 10, 15-28, 30, 32-66, 68-73, 75, 78, 80, 85-98, 100, 102-114, 116, 119, 121, 126-139, 141, and 142-152 under 35 U.S.C. § 103(a) as obvious over Ethox in view of U.S. Patent No. 6,165,480 ("Kasat"). (November 14, 2003, Office Action, pp. 4-5.) Applicant respectfully traverses this rejection.

The Office asserts that, although Ethox does not expressly teach a cosmetic composition comprising fatty acid gellant, such as sodium stearate, and PEG 150 Dibehenate, Kasat discloses sodium stearate as a known gelling agent and it would be *prima facie* obvious to combine it with PEG 150 Dibehenate. (November 14, 2003, Office Action, p. 4.) Applicant submits that the Office has not provided sufficient motivation to combine the cited references and has failed to set forth a *prima facie* case of obviousness.

As explained above, the mere fact that the prior art could be modified in a manner to yield the claimed invention does not make the modification obvious unless the prior art suggests the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). The suggestion or motivation to modify

the reference cannot be found in Applicant's disclosure. M.P.E.P. § 2143; *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, neither reference teaches or suggests the desirability of a cosmetic composition containing PEG 150 Dibehenate and sodium stearate. Once again, the art would actually teach away from such a combination since Kasat discloses solid compositions (col. 4, Ins. 29-36) and Ethox is used for "gel formulations." The Office is engaging in impermissible hindsight in using the prior art to arrive at the present invention. Furthermore, neither reference suggests, let alone teaches, the emulsions and multiple emulsions of the present invention. Thus, Applicant respectfully requests withdrawal of this rejection.

C. JP 2002-003891 in view of Ethox Chemicals Product Specification for Ethox PEG-6000 DB

The Office has also rejected claims 1-3, 5, 8, 10, 15-28, 30, 32-66, 68-73, 75, 78, 80, 85-98, 100, 102-114, 116, 119, 121, 126-139, 141, and 142-152 under 35 U.S.C. § 103(a) as obvious over JP 2002-003891 ("Katsuo") in view of Ethox. (November 14, 2003, Office Action, pp. 5-6.) Applicant respectfully traverses this rejection.

The Office asserts that although Katsuo does not expressly teach a particular combination of sodium stearate and PEG 150 Dibehenate, it would be obvious to make a composition according to Katsuo containing these materials. (November 14, 2003, Office Action, p. 5.) Again, Applicant submits, the Office has failed to set forth a *prima facie* case of obviousness because the Office has not provided sufficient motivation to

combine the cited references and only by engaging in impermissible hindsight in using the prior art would one arrive at the present invention.

Nothing in either reference suggests combining these two particular materials, especially in view of the broad disclosure of Katsuo, let alone suggests that a stable compound would result. The mere fact that the prior art could be modified in a manner to yield the claimed invention does not make the modification obvious unless the prior art suggests the desirability of the modification. Thus, Applicant respectfully requests withdrawal of this rejection.

III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests withdrawal of these rejections and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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